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Scott Thomas Loughran

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THE PROCTER & GAMBLE COMPANY  
Global Legal Department - IP  
Sycamore Building - 4th Floor  
299 East Sixth Street  
CINCINNATI, OH 45202

EXAMINER

GHALI, ISIS A D

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



### **DETAILED ACTION**

The receipt is acknowledged of applicants' reply to the office action under 37 CFR § 1.111(b) filed 12/11/2008.

Claims 4-6, 10-18 and 21-23 have been canceled.

Claims 1-3, 7-9, and 19-20 are pending and included in the prosecution.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-3, 7-9, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,221,211 ('211) in view of US 4,325,768 ('768), and optionally in view of US 2004/0118530 ('530).

US '211 teaches multi-ply tissue product containing indicia to indicate the presence of some unique ingredients within the tissue product (abstract). The tissue comprises more than one fibrous plies that are glued together, i.e. adhesive (col.1, lines 39-45; col.2, lines 34-41). The reference disclosed facial and bath tissue and the indicia are coloring or printing on the internal ply surface, i.e. contacting the glue (col.1, lines 20-30). The indicia are color other than white or decorative pattern (col.2, lines 13-23). The indicia include ingredients such as emollient, moisturizers, softening agent, menthol (aromatherapy), cleansing agent and fragrance (col.2, lines 42-44, 53-58; col.4, lines 59-64).

US '211 does not teach the as embossment as instantly claimed by claim 1.

US '768 teaches laminated creped fibrous web material with embossed pattern i.e. non-verbal cue (abstract). Embossment provides the desired bulk and aesthetic appearance of the web (col.4, lines 3-4, 14-16).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide multi-ply tissue product having non-verbal cue as disclosed by US '211, and further add embossment to the plies as disclosed by US

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'768, motivated by the teaching of US '768 that such embossment provides the desired bulk and aesthetic appearance of the product, with reasonable expectation of having multi-ply tissue product having non-verbal cue in form of embossment that provides bulk and aesthetic appearance to the product.

Although US '211 teaches active agents included in the fibrous product such as emollient, moisturizers, cleansing agent and softening agent, however, US '211 does not explicitly teach the specific ingredients as claimed in claims 7-9, or the package of the product as claimed in claim 1.

US '211 teaches emollient, moisturizers, cleansing agent and softening agent that encompass all chamomile, aloe and vitamin E, and one having ordinary skill in the art at the time of the invention would have selected the specific ingredient according to the specific intended use, motivated by personal individual needs and the knowledge of the pharmaceutical art.

Further, one having ordinary skill in the art would have packaged the product disclosed by US '211 motivated by the general knowledge to one skilled in the art that packaging protects the product during storage and handling, with reasonable expectation of having the product of US '211 in a package.

US '530 teaches facial or bath tissue or wipe product comprising fibrous material and patterned indicia (abstract; paragraphs 0009, 0013, 0014). The products are packaged for eventual sale to the consumer (paragraph 0048).

One having ordinary skill in the art at the time of the invention would have been motivated to provide multi-ply tissue product having non-verbal cue in form of

embossment as disclosed by the combined teaching of US '211 and US '768, and package the product as disclosed by US '530, motivated by the teaching of US '530 that packaging make the product ready for eventual sale, with reasonable expectation of having a packaged product having long shelf life and storage stability.

### ***Response to Arguments***

4. Applicant's arguments filed 12/11/2008 have been fully considered but they are not persuasive. Applicants argue that Hollenberg (US '211) in view of Schulz (US '768) and optionally in view of Kressner (US '530) fails to teach each and every element of the independent claim 1, because they fail to teach that their fibrous structures that comprise a colored ply bond adhesive, which comprises an ingredient, are packaged in an external package, which itself comprises a non-verbal cue that communicates the ingredient. Applicants argue that claims 2-3, 7-9 and 19-20, which ultimately depend from claim 1, are not render obvious over the combination of the references.

In response to this argument, applicants' attention is drawn to scope of the present claim 1 that is directed to product, and all the elements of the product are disclosed by the combination of the references. US '211 teaches facial and bath tissue comprising indicia that are colored other than white and comprises more than one fibrous plies that are glued together, i.e. adhere with adhesive. US '211 further teaches active ingredient in the indicia of the facial tissue as required by claim 1. The combination of US 211 and US '768 teaches the embossment. The colored or printed indicia disclosed by US '211 read on the claimed non-verbal cue. Further, the

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embossment disclosed by the combination of US '211 and US '768 read on non-verbal cue. Regarding communication of the non-verbal cue to the user, this limitation is directed to the intended use of the product, and does not impart patentability to product claims. Regarding the argument concerning the references do not teach the package, it is argued that the package is taught by US '530 and any color or printing on the package read on non-verbal cue. In any event, package does not impart patentable weight with absent functional relationship between the package and the product, and because the product still function equally effectively with or without the package. It has been held by the court that aesthetic changes that have no mechanical function cannot be relied upon to patentability distinguish the claimed invention from the prior art. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

The present invention as a whole is taught by the combined teachings of the references. It is well established that the claims are given the broadest interpretation during examination. A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 U.S.C. 103 (a). It has been held "When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int '1 Co. v.*

*Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273,282 (1976)). "When the question is whether a patent claiming the combination of elements of prior art is obvious," the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions."

5. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of US '211 and US '768, and optionally in view of US '530, and further in view of US 6,905,697 ('697).

The combined teachings of US '211, US '768 and optionally US '530 are discussed in section 4 as set forth in this office action.

Although US '211 teaches active agents included in the fibrous product such as emollient, moisturizers, cleansing agent and softening agent, however, US '211 does not explicitly teach chamomile as claimed by claim 7, aloe lotion as claimed by claim 8 or vitamin E as claimed by claim 9.

US '697 teaches fibrous web, in particular tissue web comprising lotion comprising cosmetic agent (abstract). Preferred cosmetic agent included aloe vera, chamomile, and vitamin E (col.12, lines 59-64; col.13, line 7). The web feels pleasant to the skin and if necessary capable of transferring active agents to the skin of the user (col.3, lines 55-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide packaged multi-ply tissue product comprising active



agent and having non-verbal cue in form of embossment as disclosed by the combination of US '211 and US '768 and optionally US 530, and further select the active agent from chamomile, aloe vera lotion or vitamin E as disclosed by US '697 because US '697 teaches that fibrous web comprising such agents will deliver such preferred cosmetic to the skin if necessary, with reasonable expectation of having multi-ply tissue product having non-verbal cue in form of embossment and comprising chamomile, aloe lotion or vitamin E wherein the product provides pleasant feel and simultaneously deliver necessary cosmetic to the skin of the user.

### ***Response to Arguments***

6. Applicant's arguments filed 12/11/2008 have been fully considered but they are not persuasive. Applicants argue that Claims 7-9, which depend from claim 1, are not rendered obvious for the same reasons that claim 1 is not rendered obvious over Hollenberg and optionally Kressner, as discussed above.

In response, the examiner is hereby repeats the argument regarding rejection of claim 1 over Hollenberg combined with Schulz and optionally in view of Kressner, as set forth in this office action.

7. Claims 1-3, 7-9, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,221,211 ('211) in view of US 6,905, 697 ('697).

US '211 teaches multi-ply tissue product containing indicia to indicate the presence of some unique ingredients within the tissue product (abstract). The reference

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disclosed facial and bath tissue and the indicia are coloring or printing on the internal ply surface, i.e. contacting the glue (col.1, lines 20-30). The tissue comprises more than one fibrous plies that are glued together, i.e. adhesive (col.1, lines 39-45; col.2, lines 34-41). The indicia are color other than white or decorative pattern (col.2, lines 13-23). The indicia include ingredients such as emollient, moisturizers, softening agent, menthol (aromatherapy), cleansing agent and fragrance (col.2, lines 42-44, 53-58; col.4, lines 59-64).

US '211 does not teach the as embossment and packaging as instantly claimed by claim 1. Although US '211 teaches active agents included in the fibrous product such as emollient, moisturizers, cleansing agent and softening agent, however, US '211 does not explicitly teach chamomile as claimed by claim 7, aloe lotion as claimed by claim 8 or vitamin E as claimed by claim 9.

US '697 teaches fibrous web, in particular tissue web comprising lotion comprising cosmetic agent (abstract). Preferred cosmetic agent included aloe vera, chamomile, and vitamin E (col.12, lines 59-64; col.13, line 7). The web feels pleasant to the skin and if necessary capable of transferring active agents to the skin of the user (col.3, lines 55-57). The reference teaches multiply tissue web and embossing can be used for generating ply adhesion in the multiply tissue, and further teaches that the tissues are packaged (col.14, lines 56-65; col.17, lines 5-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide multi-ply tissue product having non-verbal cue and comprising active agent as disclosed by US '211, and further add embossment to the

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plies as disclosed by US '697 because US '697 teaches that embossment is used to generate ply adhesion, which is desired by applicants, with reasonable expectation of having multi-ply tissue product having non-verbal cue in form of embossment that meanwhile generates adhesion of the ply. Further one having ordinary skill in the art would have packaged the tissues as disclosed by US '697 and as required by the logic of cosmetic art to preserve the product during handling, transportation and storage. Additionally, one having ordinary skill in the art at the time of the invention would have replaced the active agent included in the tissue product disclosed by US 211 by any of chamomile, aloe vera lotion or vitamin E as disclosed by US '697 because US '697 teaches that fibrous web comprising such agents will deliver such preferred cosmetics to the skin if necessary, with reasonable expectation of having packaged multi-ply tissue product having non-verbal cue in form of embossment and comprising chamomile, aloe lotion or vitamin E wherein the product provides pleasant feel and simultaneously deliver necessary cosmetic to the skin of the user.

### ***Response to Arguments***

8. Applicant's arguments filed 12/11/2008 have been fully considered but they are not persuasive. Applicants argue that Hollenberg in view of Baumoller (US '697) fail to teach each and every element of claim 1 because they fail to teach that their fibrous structures that comprise a colored ply bond adhesive, which comprises an ingredient, are packaged in an external package, which itself comprises a non-verbal cue that communicates the ingredient.

In response to this argument, applicants' attention is drawn to scope of the present claim 1 that is directed to product, and all the elements of the product are disclosed by the combination of the references. US '211 teaches facial and bath tissue comprising indicia that are colored other than white and comprises more than one fibrous plies that are glued together, i.e. adhere with adhesive. US '211 further teaches active ingredient in the indicia of the facial tissue as required by claim 1. The combination of US 211 and US '697 teaches the embossment. The colored or printed indicia disclosed by US '211 read on the claimed non-verbal cue. The embossment taught by the combination of US 211 and US '697 reads on non-verbal cue. Regarding the argument concerning the references do not teach the package, it is argued that the package it taught by US '697 and any color or printing on the package read on non-verbal cue. In any event the package does not impart patentable weight with absent functional relationship between the package and the product, and because the product still function equally effectively with or without the package. Regarding communication of the non-verbal cue to the user, this limitation is directed to the intended use of the product, and does not impart patentability to product claims. It has been held by the court that aesthetic changes that have no mechanical function cannot be relied upon to patentability distinguish the claimed invention from the prior art. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

The present invention as a whole is taught by the combined teachings of the references. It is well established that the claims are given the broadest interpretation during examination. A conclusion of obviousness under 35 U.S.C. 103 (a) does not

require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. In re Bozek, 163 USPQ 545 (CCPA 1969). In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 U.S.C. 103 (a). It has been held "When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." KSR Int '1 Co. v. Teleflex Inc., 127 S.Ct. 1727, 1740 (2007) (quoting Sakraida v. AG Pro, Inc., 425 U.S. 273,282 (1976)). "When the question is whether a patent claiming the combination of elements of prior art is obvious," the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions."

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 6:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Isis A Ghali/  
Primary Examiner, Art Unit 1611

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